

IN THE UNITED STATES PATENT OFFICE

In re Application of : Bradford C. Webb
Serial No: : 08/870,199
Filed : June 5, 1997
Examiner : Zohreh A Fay
Group Art Unit : 1618
Confirmation No : 6700
Title : SYNTHETIC VISCOELASTIC MATERIAL FOR
OPHTHALMIC APPLICATIONS

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This reply brief is responsive to the Examiner's Answer mailed August 13, 2008 for which the two-month period is October 13, 2008.

Status of Claims begins on page **2**.

Grounds of Rejection to be Reviewed on Appeal begins on page **3**.

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I. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 56 claims pending in the application, which are identified as claims 1-56.

B. Current Status of Claims

Claims 1-56 have been rejected.

C. Claims Appealed

The appealed claims are claims 1-56.

The claims set forth in the Claims Appendix (Section VIII) of the Appellant's Appeal Brief filed December 13, 2007 reflect all amendments to the claims made to date by Appellant in this matter. There are no outstanding amendments to the claims.

II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are as previously set forth in Section VI of Appellant's Appeal Brief filed December 13, 2007. The Examiner has acknowledged in the Examiner's Answer mailed August 13, 2008 that the grounds of rejection set forth by Appellant are correct. No additional grounds of rejection were made in the Examiner's Answer. Thus, the grounds of rejection to be reviewed are as follows:

- A. Whether claim 13 was improperly broadened by amendment under 35 U.S.C. § 251.**
- B. Whether claims 13-23 and 27-30 are unsupported by the specification under 35 U.S.C. § 112, first paragraph.**
- C. Whether claims 1-56 were properly rejected as being based on a defective reissue declaration.**

III. ARGUMENT

A. Reissue Application Claim 13 is Properly Amended

The Examiner has failed to provide evidence that the deleted claim 13 limitation “the series including a final filter having 0.5 μm openings” was relied upon for allowance of the application resulting in U.S. Patent No. 5,422,376. Failing to find such evidence, the Examiner instead submits that declarations filed by Appellant on September 12, 2000 during the reissue proceedings are evidence of a “factor considered in the patentability of the parent application.” Appellant disagrees.

The declarations referred to by the Examiner do not indicate that a final filter having 0.5 μm openings is required for operation of the invention. Claim 13 does comprise a limitation requiring that the composition be free of harmful particulate matter and gels greater than 0.5 μm in diameter. Claim 13 also requires that a filtration step is required to produce such compositions. Removal of the phrase “the series including a final filter having 0.5 μm openings” does not contradict the limitation requiring that the composition be free of harmful particulate matter and gels greater than 0.5 μm in diameter, as the Examiner contends. Instead, it merely removes the limitation requiring that a 0.5 μm filter be the final filter in a series of filters.

In sum, Appellant again asserts that there is no indication in the ‘376 patent prosecution record that the Examiner or Appellant relied on the deleted claim 13 limitation (specifying the location of a 0.5 μm filter in a series of filters) for patentability. Appellant’s claims continue to recite a limitation requiring the claimed compositions to be free of harmful particulate with greater than 0.5 μm in diameter.

B. The Specification Supports Claims 13-23 and 27-30 under 35 U.S.C. § 112

Appellant reasserts the arguments made with respect to claims 13-23 and 27-30 in the Appeal Brief. Claims 13-23 are clearly supported by the specification and meet all requirements for patentability under 35 U.S.C. § 112, first paragraph. The specification clearly notes that a filtration step is necessary and gives at least one example of a series of filters that may be used. Thus, the specification clearly supports the claim 13 limitation of “filtering the gel through a series of filters.”

Appellant notes that the Examiner has not clarified the rationale for the rejection of claims 27-30 in response to the arguments presented by Appellant in the Appeal Brief. Appellant reasserts the arguments presented in the Appeal Brief regarding claims 27-30. The specification clearly supports claims 13-23 and 27-30 and Appellant again asserts that these claims were not properly rejected under 35 U.S.C. § 112.

C. Appellant's Reissue Declaration Properly Supports All Amendments

The Examiner's argument that the Supplemental Declaration of April 4, 2004 does not address the amendments to claim 13 is incorrect. Claim 13 listed in Exhibit B of the Supplemental Declaration is identical to pending claim 13 of this reissue application. The Supplemental Declaration, Paragraph 2 clearly states that the declarant, Bradford C. Webb has reviewed and understands the claim amendments put forth in Exhibit B. Thus, the Examiner's argument regarding the supplemental declaration fails. Appellants respectfully assert that the reissue declaration properly supports all claim amendments made during prosecution of the reissue application.

IV. CONCLUSION

For the above reasons, and for the reasons set forth in Appellant's Appeal Brief, Appellant believes that the issues identified above must be resolved in favor of Appellant.

Appellant has authorized payment of the fee associated with the Request for Oral Hearing, and believes no further fee is due. However, in the event further fees are due, the Commissioner is authorized to charge any fees which may be required or to credit any overpayment to Deposit Account No. 50-1051 in the name of Alcon, Inc.

Respectfully submitted,

October 13, 2008
Date

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